

REMARKS/ARGUMENTS

In the above-mentioned Final Rejection, claim 436 was withdrawn, claims 429-435, 437-451, 453-462, 470, 474, 475 and 477 were rejected as being unpatentable over U.S. Patent No. 5,407,718 (Popat), in view of U.S. Patent No. 4,863,772 (Cross), claims 463 and 464 were rejected as being unpatentable over Popat in view of Cross and further in view of U.S. Patent No. 4,704,317 (Hickenbotham), claims 452 and 476 were rejected as being unpatentable over Popat in view of Cross, and further in view of U.S. Patent No. 5,842,722 (Carlson), and claims 465-469 and 471-473 were rejected as being unpatentable over Popat in view of Cross, and further in view of U.S. Patent No. 5,198,275 (Klein). In response thereto claims 429, 463, 464, 474-476 have been amended, claims 430, 431, 458, 462, 469, and 470 have been cancelled without prejudice or disclaimer, and new dependent claim 477 and independent claim 478 have been added. The claims as now pending are patentable for the reasons set forth below in Sections I and II.

I. The Examiner contended in the Final Rejection that the limitations of "a sheet of printable business cards" and "when the sheet of printable business cards is fed through a printer or copier for printing operation on the printable business cards" are "intended use limitations" and are not further limiting insofar as the structure of the product is concerned.

Independent claim 429 has been amended and new independent claim 478 has been written to use the phrase "adapted to" (and the preamble has been amended to read "printable business card sheet"). The descriptive phrase "adapted to" imparts structural limitations. In fact, as a matter of law, language in the body of a claim following the descriptive phrase "adapted to" is a structural limitation. For example, in In re Venezia, 530 F.2d 956, 957, 189 USPQ 149, 150 (CCPA 1976), some of the claim language at issue was "a pair of sleeves of elastomeric material ... adapted to be fitted over the insulating jacket of one of said cables." Concerning the above-quoted aspect of the claim, the Court of Customs and Patent Appeals stated that: "rather than being a

mere direction of activities to take place in the future, this language imparts a structural limitation to the sleeve. Each sleeve is so structured and dimensioned that it can be fitted over the insulating jacket of the cable.” *Id.* at 959, 189 USPQ at 151-152, emphasis added. (See also *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971).)

It is also well settled that all claim limitations must be considered and that it is improper for an examiner to ignore specific limitations that distinguish over the cited references. See, e.g., *In re Boe and Duke*, 505 F.2d 1297, 1299, 184 USPQ 38, 40 (CCPA 1974).

Thus, all language in the bodies of all of the claims pending herein must be fully considered in a patentability determination.

II. In the above-mentioned Final Rejection the claims were rejected, primarily over Popat in view of Cross. (Applicant notes that the adhesive layer of Cross is never on an exposed surface.) Popat is directed to a label sheet assembly for transparent paper adhesive labels having a substantially transparent paper label sheet with a substantially transparent, pressure sensitive adhesive coating. Each of the clear labels (26) has an adhesive layer (30) which permits the user to apply the label to a desired surface. In other words, Popat is concerned with adhesive labels and not with business cards (non-adhesive). The Examiner in her rejection stated that “[i]t would have been obvious to one having ordinary skill in the art to use the dry release label stock of Cross as the label facestock sheet construction of Popat because the dry release material would allow the labels of Popat to be non-sticky.” (Emphasis added.) In other words, the Examiner is removing the adhesive layer from the adhesive labels of Popat.

It is respectfully contended that the Examiner’s proposed modification of Popat with the teachings of Cross is an improper Section 103 rejection.

The Examiner’s attention is directed to MPEP 2143.01 where it is stated that “[i]f [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to

make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)."

(It is further stated in that section of the MPEP that "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the prior art are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).")

That is exactly what the Examiner has done in her rejection. She has rendered the prior art adhesive label of Popat to be unsatisfactory for its intended purpose, which is to adhere to another surface via its adhesive (sticky) back surface. The rejections modifying Popat in view of Cross are thus improper, and the Examiner has accordingly not met her burden of establishing a *prima facie* case of obviousness.

Concluding Remarks

In view of the foregoing, it is respectfully submitted that the claims as now pending in this application are in condition for allowance. Reexamination and reconsideration of the application, as amended and in view of the remarks above, are respectfully requested.

As a reminder, it is requested that the Change of Address filed by Applicant via facsimile on September 3, 2003 be entered in this application.

It further is requested that the Examiner with her next action make of record the prior art cited with Applicant's Information Disclosure Statements filed (a) on September 9, 2003 and (b) herewith.

If for any reason the Examiner finds the present application to be other than in condition for allowance, she is respectfully requested to telephone Applicant's undersigned counsel at (213) 689-5142 to discuss the steps necessary for placing the application in condition for allowance.

PATENT

Old Docket No.: 310048-355

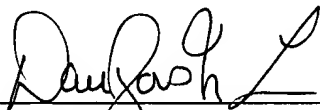
New Docket No.: 11286-01083

Avery No. 2419-US

The Commissioner is hereby authorized to charge any additional fees that may be required, or credit any overpayment to Deposit Account No. 07-1853. Should such additional fees be associated with an extension of time, Applicant respectfully requests that this paper be considered a petition therefor.

Respectfully submitted,

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